

Docket: 98-P0151US2

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Kathleen M. Miller et al.
Application No.: 10/789,398
Date Filed: 02/27/2004
Title: IMPLANTABLE OR INSERTABLE MEDICAL DEVICE RESISTANT TO MICROBIAL GROWTH AND BIOFILM FORMATION
Group Art Unit.: 3738
Confirmation No.: 4925
Atty. Docket No.: 98-P0151US2

INFORMATION DISCLOSURE STATEMENT (IDS)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

In accordance with 37 C.F.R. §1.56 and in compliance with 37 C.F.R. §§1.97 and 1.98, the references listed on attached Form PTO/SB/08 and/or subsequently identified herein, are being submitted herewith for consideration by the United States Patent and Trademark Office.

I. COPIES

- a. ☐ A legible copy of (i) each foreign patent; (ii) each publication or that portion which caused it to be listed; and (iii) all other information or that portion which caused it to be listed, is included herewith.
- b. ☐ Any patents, publications or other information which are listed on PTO/SB/08 which are not enclosed herewith were previously cited by or submitted to the PTO in one of the following applications which has been relied upon for an earlier filing date under 35 U.S.C. §120:

U.S. Serial Number

U.S. Filing Date

II. CONCISE EXPLANATION OF THE RELEVANCE (check at least one box)

- a. ☐ Except as may be indicated below in (b) of this section, all of the patents, publications or other information are in the English language (concise explanation not required).
- b. ☐ A concise explanation of the relevance of all patents, publications or other information listed that is not in the English language is as follows:
- c. ☒ The following additional information is provided for the Examiner's consideration:

Applicant is disclosing the following co-pending applications and issued patents which it believes are related to the instant application. For each such co-pending application or related patent, Applicant has identified the specific claims which, upon information and belief, may present non-statutory obviousness-type double patenting issues with the instant application claims. Upon information and belief, Applicant believes that the co-pending applications and patents cited in the IDS do not pose statutory same-type double patenting issues under 35 U.S.C. 101 with respect to the claims of the instant application.

1) U.S. Pat. No. 6,887,270

The instant application is a continuation-in-part of U.S.S.N. 10/071,840, which is now U.S. Patent No. 6,887,270 ('270 patent). Combinations of base claim 1 and dependent claims 33-38 of the '270 patent may pose non-statutory obviousness-type double patenting issues with respect to the claims of the instant application.

Docket: 98-P0151US2

2) U.S. Pat. No. 6,921,390

Combinations of base claim 1 and dependent claims 8, 9, 13, 27, and 28 may pose non-statutory obviousness-type double-patenting issues with respect to the claims of the instant application.

3) U.S.S.N. 11/125,296 (US 2006/0264912)

Combinations of base claim 1 and dependent claims 13, 22, 24, 25, 30, 32, and 33 may pose non-statutory obviousness-type double patenting issues with respect to the claims of the instant application.

4) U.S.S.N. 10/377,131 (US 2003/0224033)

Combinations of base claim 9 and dependent claims 15-18, 25-27 and 29-30 may pose non-statutory obviousness-type double-patenting issues with respect to claims of the instant application.

5) U.S.S.N. 10/209,476 (US 2004/0022824)

Combinations of base claim 1 and dependent claims 2-3 and base claim 11 and dependent claims 11-12 may pose non-statutory obviousness-type double-patenting issues with respect to claims of the instant application.

6) U.S.S.N. 11/188,367 (US 2005/0271698)

Combinations of base claim 1 and dependent claims 8, 9, and 14 may pose non-statutory obviousness-type double-patenting issues with respect to claims of the instant application.

7) U.S.S.N. 11/040,864 (US 2005/0161859)

Combination of base claim 1 and dependent claim 22 may pose non-statutory obviousness-type double-patenting issues with respect to claims of the instant application.

III. ☒ CROSS REFERENCE TO RELATED APPLICATION(S)

The Examiner is advised that the following co-pending application(s) contain(s) subject matter that may be related to the present application. By bringing this (these) applications to the Examiner's attention, Applicant(s) does (do) not waive the confidentiality provisions of 35 U.S.C. §122.

<u>Serial No.</u>	<u>Filing Date</u>
11/125,296 (US 2006/0264912)	May 9, 2005
10/377,131 (US 2003/0224033)	February 28, 2003
10/209,476 (US 2004/0022824)	July 31, 2002
11/188,367 (US 2005/0271698)	July 25, 2005
11/040,864 (US 2005/0161859)	January 21, 2005

FEES

IV. ☒ THIS IDS IS BEING FILED UNDER 37 C.F.R. §1.97(b): (check one box)

- a. ☐ within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d) (37 C.F.R. §1.97(b)(1)). No fee or statement is required.
- b. ☐ within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. §1.97(b)(2)). No fee or statement is required.
- c. ☒ before the mailing date of a first Office Action on the merits (37 C.F.R. §1.97(b)(3)). No fee or statement is required.

Docket: 98-P0151US2

- d. ☐ before the mailing date of a first Office Action after the filing of a request for continued examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.
- V. ☐ THIS IDS IS BEING FILED UNDER 37 C.F.R. §1.97(c): (check one box)
before the mailing date of any of a Final Office Action under 37 C.F.R. §1.113, a Notice of Allowance under 37 C.F.R. §1.311, or an action that otherwise closes prosecution in the application (See 37 C.F.R. §1.97(c)).
- a. ☐ No statement; therefore, charge deposit account 50-1047 the fee set forth in 37 C.F.R. §1.17(p).
- b. ☐ See the statement below. No fee is required.
- VI. ☐ THIS IDS IS BEING FILED UNDER 37 C.F.R. §1.97(d):
on or before payment of the issue fee and is accompanied by the following:
- 1) a statement under 37 C.F.R. §1.97(e) as provided below; and
- 2) charge deposit account 50-1047 the petition fee set forth in §1.17(p).
- VII. ☐ STATEMENT UNDER 37 C.F.R. §1.97(e) (check only one box, if applicable)
The undersigned hereby states that
- a. ☐ each item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of IDS; or
- b. ☐ no item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and to knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. 1.56(c) more than three months prior to the filing of this statement, or
- c. ☐ some of the items of information contained in the IDS were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application or, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. 1.56(c) more than three months prior to the filing of this statement.
- VIII. PAYMENT OF FEES
- ☐ A check in the amount of _____ is enclosed for the above-identified fee(s).
- ☐ Please charge Deposit Account No. 50-1047 in the amount of \$180.00 for the above-indicated fee(s).
- ☒ If Applicant has overlooked any additional fees, or if any overpayment has been made, the Commissioner is hereby authorized to credit or debit Deposit Account 50-1047.
- ☐ Two Copies of this paper are attached for Deposit Account charges and debits.

It is Applicant(s)' opinion that the claims presently on file patently distinguish the present invention from each of these references. The above references are being cited only in the interests of candor and without any admission that they constitute statutory prior art or contain matter which anticipates the invention or which would render the same obvious, either singly or in a combination, to a person of ordinary skill in the art.

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule (with a petition if necessary) and charge the appropriate fee to Deposit Account No. 50-1047.

Docket: 98-P0151US2

Respectfully submitted,



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MAYER & WILLIAMS
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Enclosures:



PTO/SB/08
References
Foreign Search Report
Other:

Certificate of Facsimile Transmission

I hereby certify that this correspondence and any document referenced herein is being sent to the United States Patent and Trademark office via Facsimile to: 571-273-8300 on 4/26/07

Marjorie Scariati
(Printed Name of Person Sending
Correspondence)

Marjorie Scariati
(Signature)

Docket No.: 98-P0151US2

Please type a plus sign (+) inside this box. FORM PTO/SB/08

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Complete if Known	
		Application Number	10/789,398
		Filing Date	02/27/2004
		First Named Inventor	Kathleen M. Miller
		Group Art Unit	3738
		Examiner Name	Thomas Sweet
Sheet 1 of 1	Attorney Docket Number	98-P0151US2	

Examiner Initials*	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Issue Date MM-DD-YYYY
		Number	class/Subclass		
	1.	6,887,270 B2	623/11.11	Miller et al.	05-03-2005
	2.	6,921,390 B2	604/265	Bucay-Couto et al.	07-26-2005

Examiner Initials*	Cite No. ¹	U.S. Patent Publication		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY
		Number	Class/Subclass		
	1.	2003/0224033 A1	424/423	Li et al.	12-04-2003
	2.	2004/0022824 A1	424/423	Li et al.	02-05-2004
	3.	2005/0161859 A1	264/209.1	Miller et al.	07-28-2005
	4.	2005/0271698 A1	424/423	Bucay-Couto et al.	12-08-2005
	5.	2005/0255230 A1	427/2.1	Clerc et al.	11-17-2005
	6.	2006/0264912 A1	604/891.1	Mcintyre et al.	11-23-2006

Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹²Unique citation designation number. ²Applicant is to place a check mark here if English language Translation is attached.
 Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and trademark Office, Washington, DC 20231.
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